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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,516	10/15/2001	Hwai-Tay Lin	CFP-1489	5040

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EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 04/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978,516

Applicant(s)

LIN, HWAI-TAY

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,9-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,9-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Golsch (US 4,932,480).

In regard to claims 1 and 5, Golsch discloses the invention as claimed including a tool 10, a head portion, which holds cylinder 20, inner peripheral wall 22, with plural ports 80, end wall 24, with through hole 36, piston 26, with mounted driving element 32 and bumper 70, with gaps 112 that are arranged in an annular manner on the bumper that allow the passage of air into the tool (see figures 1,2 and C6, L58-68).

In regard to claim 2, Golsch discloses the invention as claimed including a bumper 70, with an enlarged section 108, in contact with a recess 82 of the cylindrical wall 24 (see Figs. 2-4, 6 and C6, L22-34). In regard to claim 3, Golsch discloses the invention as claimed including inner wall 202, and connecting wall in the form of a recess 214 that secures the bumper in place (see Fig. 6 and C8, L36-49).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4,9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golsch (US 4,932,480) in view of Boothby et al (US 5,617,925).

Golsch discloses the invention substantially as claimed including a head portion that contains ports 80 and gaps 112 not in contact with inner peripheral wall 22 and an annular connecting wall 82 at a different level than of the inner peripheral wall 22 (see figures 1 and 2). What Golsch does not disclose is a tool comprised of combustion power. However, the examiner takes Official Notice that it is old and well known in the art to provide a driving tool powered by combustion for the purpose of increasing operational efficiency.

5. Claims 7,11,13 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golsch in view of Boothby et al and in further view of Kemper et al (US 4,050,505).

Golsch and Boothby disclose the invention substantially as claimed including a bumper 70, flanged section 108 that abuts annular connecting wall 82, annular connecting wall 82 at a different level than of the inner peripheral wall 22 and plural ports 80. What Golsch and Boothby do not disclose is the specifics of a two piece bumper. However Kemper teaches that it is old and well known in the art to provide a two piece bumper that has an enlarged second section 9, that is less rigid than a first section 7, and abuts an end wall 13 and an inner wall for the purpose of reducing tool wear (see Figs. 1,2 and C2, L65 – C3, L7). Therefore, it would have been obvious to

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one having ordinary skill in the art to have provided the tool of Golsch with the bumper elements as taught by Kemper for the purposes of reducing tool wear.

In regard to claim 13, Golsch discloses the invention substantially as claimed including a head portion that contains ports 80 and gaps 112 not in contact with inner peripheral wall 22 and an annular connecting wall 82 at a different level than of the inner peripheral wall 22 (see figures 1 and 2). What Golsch does not disclose is a tool comprised of combustion power. However, the examiner takes Official Notice that it is old and well known in the art to provide a driving tool powered by combustion for the purpose of increasing operational efficiency.

### ***Response to Arguments***

6. Applicant's arguments filed 2/7/2003 have been fully considered but they are not persuasive.

Applicant argues that the primary teaching of Golsch does not teach of a "gap" that is located between the cylinder wall and the bumper element. As the examiner understand the cited references. Golsch clearly shows that it is well known to provide "gaps" or "slots" that are arranged annularly on the bumper that has a flange diameter that is larger than the body portion.

Applicant further argues that the teachings of Boothby and Kemper et al do not suggest an annular gap for the transfer of air. While the Examiner agrees the teaching do not suggest this, the Examiner does contend that the use of the teachings was to

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show the applicant that the concept of using cushioning material for driving tools that are comprised of different impact resistant materials is well known within the art.

Applicant furthers argues that the cited prior art on PTO-892 lists references that are not applicable to the present invention. However, the Examiner has provided the references based on certain concepts of the applicant's invention and not the overall invention as a whole as it pertains to the claims.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul Durand  
April 14, 2003

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal flourish extending to the right.

Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700